



PATENT #6 DW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

CAPLAN, et al.

Serial No.: 09/625,228

Filed: 24 July 2000

For: MODULAR RACK FOR
COMPACT DISCS

Examiner: Not Yet Known

Art Unit: Not Yet Known

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Signed: 

Todd V. Leone

Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT
(37 C.F.R. §1.102 and M.P.E.P. §708.02)

Applicants hereby petition to make this application special because of actual infringement.

Accompanying this Petition is a Second Preliminary Amendment, a Statement of Facts by Inventor Charles E. Taylor in Support of Petition to Make Special Because of Actual Infringement, and a Statement by Patent Counsel in Support of Petition to Make Special Because of Actual Infringement.

The fee required to be paid by 37 C.F.R. §1.17 is paid by attached Check No. 34072 in the amount of \$130.00.

01/31/2001 NGUYEN 00000016 09625228

01 FC:103

36.00-6P

The Commissioner is authorized to charge any additional fees that may be required, including extension fees, or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. A-67467-2/MAK).

Respectfully submitted,


FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP

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By


Michael A. Kaufman
Reg. no. 32,998

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**STATEMENT BY PATENT COUNSEL IN SUPPORT OF
PETITION TO MAKE SPECIAL BECAUSE OF
ACTUAL INFRINGEMENT (M.P.E.P. §708.02)**

I, MICHAEL A. KAUFMAN, am a patent attorney for applicants and for assignee Sharper Image Corp. herein; my USPTO registration number is 32,998.

I hereby state the following:

1. I have made a careful comparison of the alleged infringing holder that is found in the Brookstone Corp. CD Rack shown in Fig. 6B in the group of photographs attached to the STATEMENT OF FACTS BY CHARLES E. TAYLOR (the "Taylor Statement") submitted herewith. The Brookstone Corp. holder component found in said CD rack is shown in Figs. 1B, 2B, 3B, 4B, and 5B. For purposes of comparison, Figs. 1A, 2A, 3A, 4A, and 5A depict the holder component in the Sharper Image product that is the subject of the pending application, which product is depicted in Fig. 6A.

2. As shown by the Taylor Statement, assignee Sharper Image Corp. first became aware of the competing Brookstone Corp. product in October 2000. It was not until the Brookstone CD Rack product was purchased, received, dismantled, and examined in December 2000 that an opinion as to patent infringement could be formed. I first viewed the allegedly infringing Brookstone Corp. product in December 2000, at which time I requested a series of photographs be made, copies of which photographs are attached to the Taylor Statement submitted herewith.

3. On behalf of applicants and assignee, a search for potentially material prior art has previously been made, and applicants have previously submitted herein by way of IDS potentially material prior art references of which they are aware. These references include citations from parent U.S. application serial no. 09/240,308 (filed 29 January 1999), and from the European counterpart thereof PCT/US00/01707 (filed 24 January 2000). I have reviewed and have a good knowledge of these references.

4. The PCT International Search Report found references DE 93 13 107 U (Pacha Horst), DE 196 02 585A (Moeller Braun Carsten), and DE 195 09 9 A (Langanke Olaf) to be of particular relevance against the claims then pending. These references appear more relevant than references previously known to applicants. (Copies of these German references have been submitted herein by way of IDS.)

The holder depicted in DE 93 12 107 in Fig. 1b, Fig. 8a, and Fig. 9 comprises four separate components: a cassette holder 10, a connecting element 20, and two attachment screws or bolts 9. As best seen in Fig. 7b and Fig. 5, while adjacent connecting elements 20 seem to link-together, cassette holder 10 must be screwed (with attachments 9) into connecting elements 20. Thus, in contrast to the presently claimed holder, the holder in DE '107 is not a one-piece holder that matingly interlocks with other such holders to form a continuous loop of such holders, where each holder can retain a CD jewel case. Further, the present invention provides a preferably injection-moldable one-piece holder, whereas the multi-piece holder configurations shown in DE '107 do not appear to lend themselves to such injection molding fabrication.

The holder depicted in DE 196 02 585A is also not a one-piece holder. Instead, this reference discloses a door hinge construction in which hinge-tube portions 6 on one component part fit next to hinge-tube portions 7 on another component part such that an axle-like joiner element 8 passes through the concentric openings in the side-by-side hinge-tube portions 6 and 7 (see Figs. 2-8). It appears that a separate chain 3 is also used to rotate a loop comprising the various elements and their individual axle-like joiners. Again, it is submitted that the multi-piece holder configurations of DE '585A are not injection moldable as a single holder, in contrast to the present invention.

The holder depicted in DE 195 09 911 is also not a one-piece holder, as is evident from Fig. 6 therein. Holder component 3 appears to have a separate a hinge-like portion attached that is attached by an axle pin 5 to a hinge-like portion 4, that may be located on another such holder (although Fig. 6 is not clear on this point).

5. It is my opinion that each of the now pending claims 15-21, 23, and 27-46 is patentable over the prior art that has been submitted herein, including the three German references distinguished above.

6. It is further my opinion and belief that pending claims 15-19, 23, 27-33, 36-42, and 45-46 are literally infringed by the holder found on the Brookstone CD Rack product. This opinion is not surprising, given that the Brookstone Corp. holder is a carbon copy of the Sharper Image Corp. holder, as evidenced by the similarity, if not identity, between Figs. 1A and 1B, Figs. 2A and 2B, Figs. 3A and 3B, Figs. 4A and 4B, and Figs. 5A and 5B, submitted with the accompanying statement of Charles E. Taylor, filed herewith.

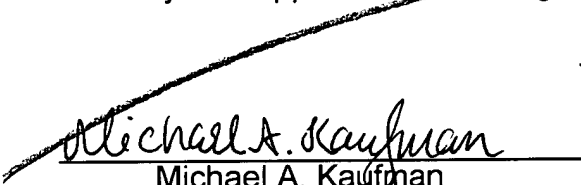
Referring to independent claims 15, 27, and 37, the Brookstone Corp. holder has every element recited in each of these claims. As to dependent claims 16, 31, 32, 44, and 45, although not visible in the attached figures, the Brookstone Corp. holder does include the claimed projecting member or projection disposed as claimed. As to dependent claims 17, 18, 28, 36, and 38, the Brookstone Corp. holder is a one-piece holder that is injection-moldable, and is in fact injection molded from plastic (see accompanying Statement of Charles E. Taylor). As to dependent claim 19, the Brookstone Corp. holder is sized and

configured to retain a compact disk jewel case. Each element recited in claim 23 is present in the Brookstone Corp. holder. As to claims 28, 29, 30, 39 and 40, the configuration and dimensions of the Brookstone Corp. holder are as set forth in these five claims. As to dependent claims 33 and 42, the Brookstone Corp. includes such an L-shaped interlock member. As to dependent claim 41, the Brookstone Corp. holder includes each element recited in this claim.

Stated differently, the only pending claims not literally infringed by the Brookstone Corp. holder are claims 20, 21, 34, 35, and 43, which claims are directed to a holder that can retain two CD jewel cases.

DATED: January 19, 2001

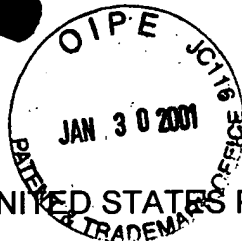
FLEHR HOHBACH TEST
ALBRITTON AND HERBERT, LLP
Attorneys for Applicants and Assignee



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Reg. No. 32,998

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Signed: _____

Todd V. Leone

Assistant Commissioner for Patents
Washington, D.C. 20231

**STATEMENT OF FACTS BY INVENTOR CHARLES E. TAYLOR
IN SUPPORT OF PETITION TO MAKE SPECIAL BECAUSE OF
ACTUAL INFRINGEMENT (M.P.E.P. §708.02)**

I CHARLES E. TAYLOR am a named inventor of the within application, and am an employee and an officer of assignee Sharper Image Corporation.

I hereby state the following:

1. I am a named inventor herein of a product commercially known as the Sharper Image CD Tower, which product is the subject of the within application.

2. On approximately 13 October 2000, an employee of Sharper Image Corporation purchased via a Brookstone.com Internet advertisement a CD Rack product commercially offered for sale by Brookstone Corporation (hereafter "Brookstone"), a business competitor of Sharper Image Corp. ATTACHMENT 1, herein, is a true copy of the packing slip that accompanied the purchase.

ATTACHMENT 1 reflects that the Brookstone CD Rack product was shipped from a Brookstone facility in Missouri, United States, to the purchaser in Alameda, California, United States. (Portions of ATTACHMENT 1 that may include the purchaser's address and credit card information are redacted.) Prior to approximately 13 October 2000, it was not known by Sharper Image Corp. that Brookstone had introduced into the U.S. market a product similar to the Sharper Image CD Tower.

3. I caused digital photographs of the Brookstone product (and especially the holder portion thereof) received in response to the above order to be taken. I have personally viewed and have helped dismantle this Brookstone product for better inspection with respect to determining similarity to the Sharper Image CD Tower product that is the subject of the within patent application, and to determining infringement of pending claims therein.

4. The Brookstone product retains CD jewel cases in a continuous loop formed from interlocking holders. The loop is rotated by a small DC motor within the product. This is similar to the use of interlocking holders that retain plastic CD jewel cases and form a continuous loop that is rotated by a small DC motor in the Sharper Image CD Tower product.

5. The interlocking holders used in the Brookstone product are essentially carbon copy clones of the interlocking holders shown in various of applicants' Figs. 4, 5, 8, and 9 filed in the within specification, and as claimed herein. In fact, the holders are so slavishly copied as to make it difficult for me to instantly know whether a holder is a Sharper Image holder or a Brookstone Corp. copy of a Sharper Image holder.

6. Attached are copies of digital photographs of applicants' interlocking holders, and of the Brookstone interlocking holders, as found on the Brookstone product purchased on 13 October 2000, as well as a digital photograph of applicants' CD Tower product and of Brookstone's competing CD Rack product.

Applicants interlocking holders are injection molded from black colored plastic, although any colored plastic or indeed transparent plastic could be used. The Brookstone interlocking holders are also injection molded from black

colored plastic. Because black colored plastic is difficult to photograph, applicants' interlocking holders, and the Brookstone interlocking holders were sprayed with a silver-white colored paint before taking the digital photographs attached hereto. (The paint in no way altered the shape holder being photograph.)

The attached figures are identified as follows:

Fig. 1A is a photograph of two of applicants' holders, spaced-apart and not yet matingly interlocked with each other;

Fig. 1B is a photograph of two of Brookstone's holders, spaced-apart and not yet matingly interlocked with each other;

Fig. 2A is a photograph of two of applicants' holders, spaced-apart and not yet matingly interlocked with each other, with a CD jewel case retained by each holder;

Fig. 2B is a photograph of two of Brookstone's holders, spaced-apart and not yet matingly interlocked with each other, with a CD jewel case retained by each holder;

Fig. 3A is a photograph showing ten of applicants' holders matingly interlocked with each other, for example as might appear at the upper portion of a loop of matingly interconnected such holders, as shown in the top of Fig. 1 in the Specification;

Fig. 3B is a photograph showing ten of Brookstone's holders matingly interlocked with each other, for example as might appear at the upper portion of a loop of matingly interconnected such holders, as shown in the top of Fig. 1 in the Specification;

Fig. 4A is a photograph showing the bottom of ten of applicants' holders matingly interlocked with each other;

Fig. 4B is a photograph showing the bottom of ten of Brookstone's holders matingly interlocked with each other; (these holders happened to be photographed in more of a fanout position than the holders of Fig. 4A);

Fig. 5A is a photograph showing ten of applicants' holders matingly interlocked with each other, with two holders each retaining a CD jewel case;

Fig. 5B is a photograph showing ten of Brookstone's holders matingly interlocked with each other, with two holders each retaining a CD jewel case;


FIG. 6A is a photograph showing applicants' modular CD rack, with several holders at the top retaining CD jewel cases; and

FIG. 6B is a photograph showing Brookstone's modular CD rack, as purchased on 13 October 2000 (see EXHIBIT 1) with several holders at the top retaining CD jewel cases.

7. I have reviewed with patent counsel the Second Preliminary Amendment being filed herewith, as well as the claims not cancelled by this Amendment. I have also reviewed the Statement by Patent Counsel in Support of Petition to Make Special Because of Actual Infringement being filed herewith.

8. Based upon my examination of the Brookstone Corp. holders, and of the now pending claims, I agree with the Statement by Patent Counsel in Support of Petition, etc. that the Brookstone interlocking holders (depicted herein in Figs. 1B 2B, 3B, 4B, and 5B) as found on the Brookstone Corp. CD rack product (depicted herein in Fig. 6B) infringe pending claims 15-19, 23, 27-33, 36-42, and 45-46. It is my opinion that actual infringement of these claims by the Brookstone Corp. holder found in its CD Rack product occurs.

DATED: January 19, 2001


Charles E. Taylor
Applicant herein

Brookstone

MAIL ORDER PROCESSING CENTER
1655 BASSFORD DRIVE MEXICO, MISSOURI 65265-1382
1-800-846-3000

PACKING SLIP

ACCT.#:

ORD.#:

SHIP TO:

MR. THOMAS J. KRYSIAK

ALAMEDA, CA 94502

MR. THOMAS J. KRYSIAK

ALAMEDA, CA 94502

| QUANTITY | ITEM NO. | DESCRIPTION | UNIT PRICE | EXTENDED PRICE |
|----------|----------|---------------------|------------|----------------|
| 1 | 264492 | CD TONER ELECTRONIC | 149.00 | 149.00 |

B

10/13/00 1XPH MISC 10/24/00

Net Product \$ 149.00
Sales Tax 12.29
P & H 22.95
Total Shipment \$ 184.24
Amt Charged to VI 184.24

ATTACHMENT 1

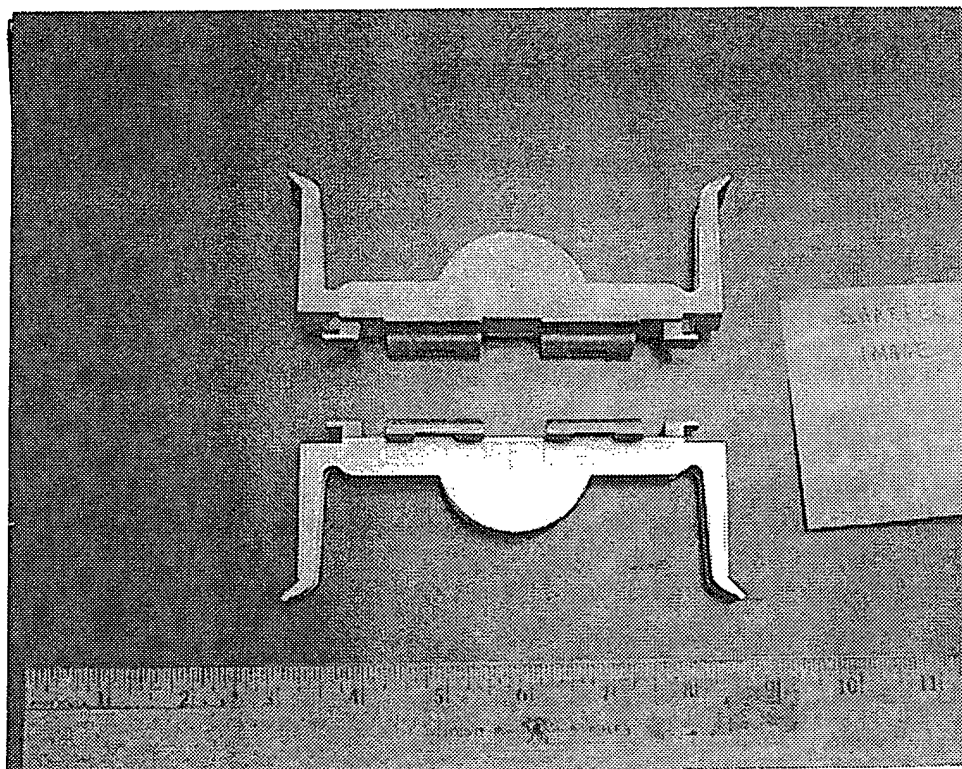


FIG. 1A
(SHARPER IMAGE)

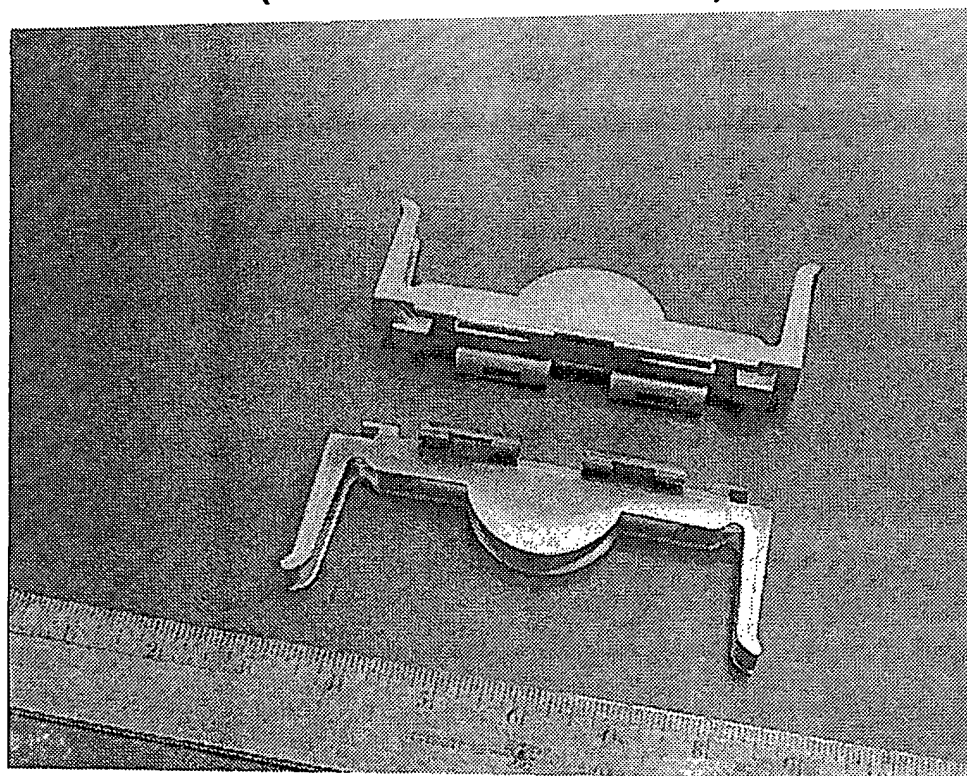


FIG. 1B
(BROOKSTONE COPY)

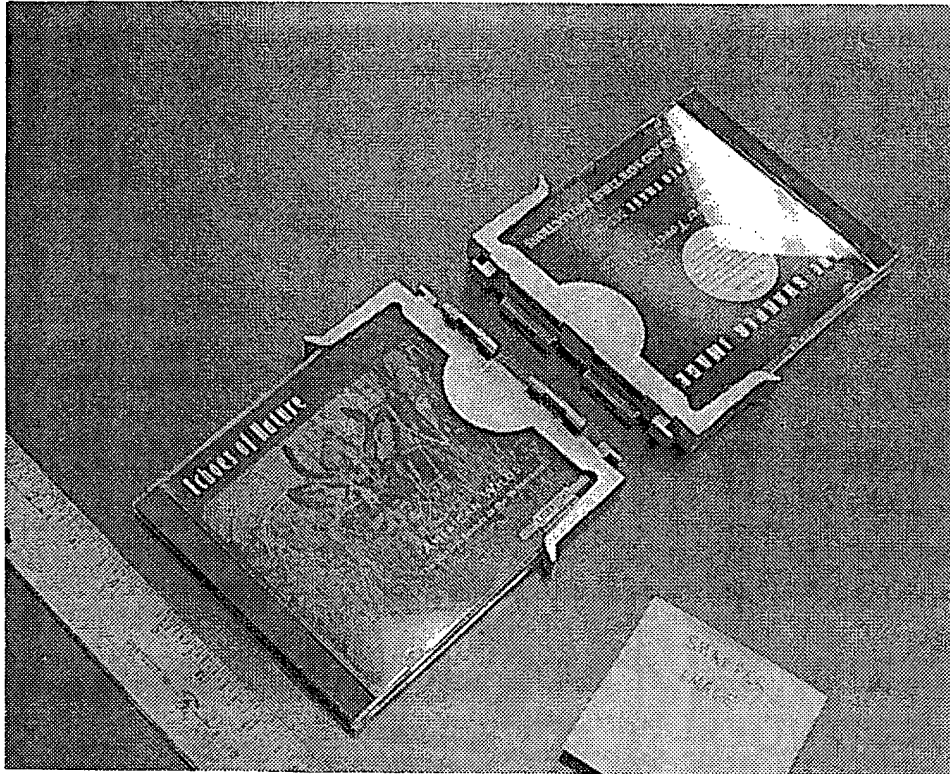


FIG. 2A
(SHARPER IMAGE)

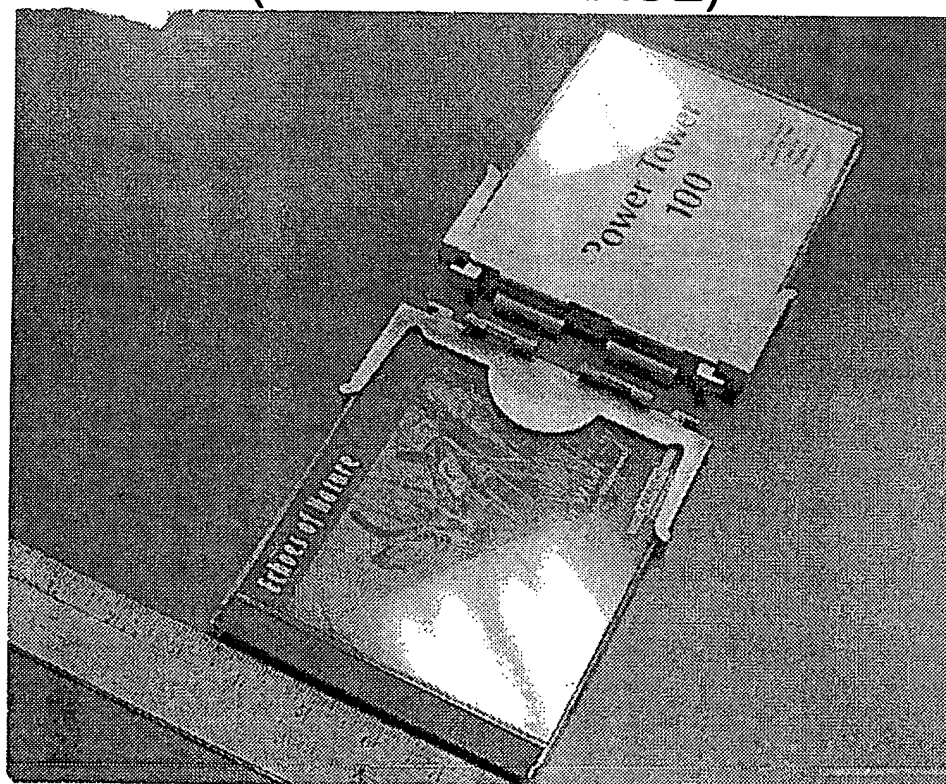


FIG. 2B
(BROOKSTONE COPY)

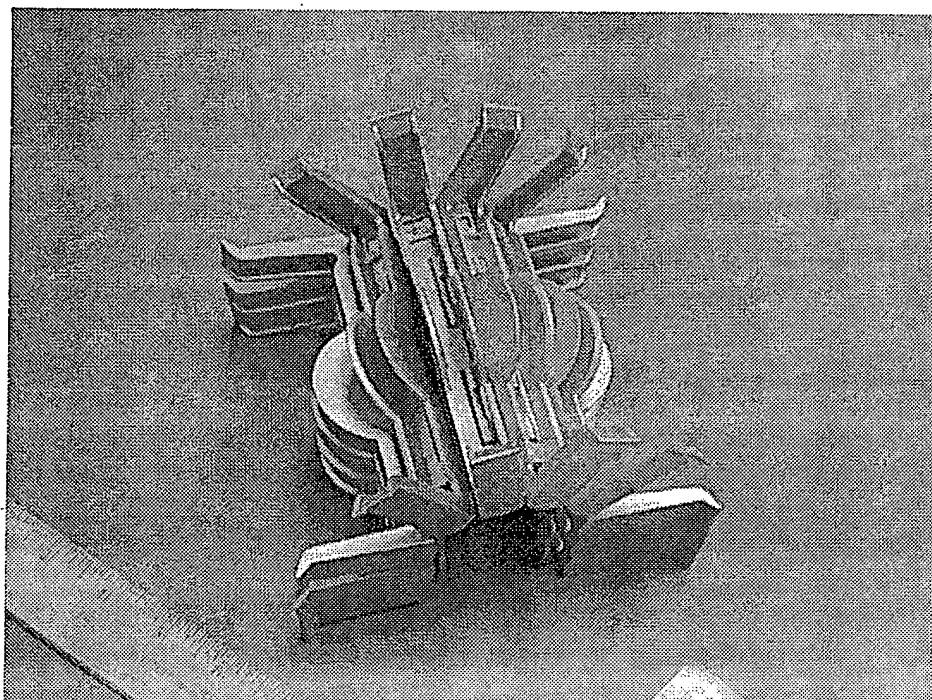


FIG. 3A
(SHARPER IMAGE)

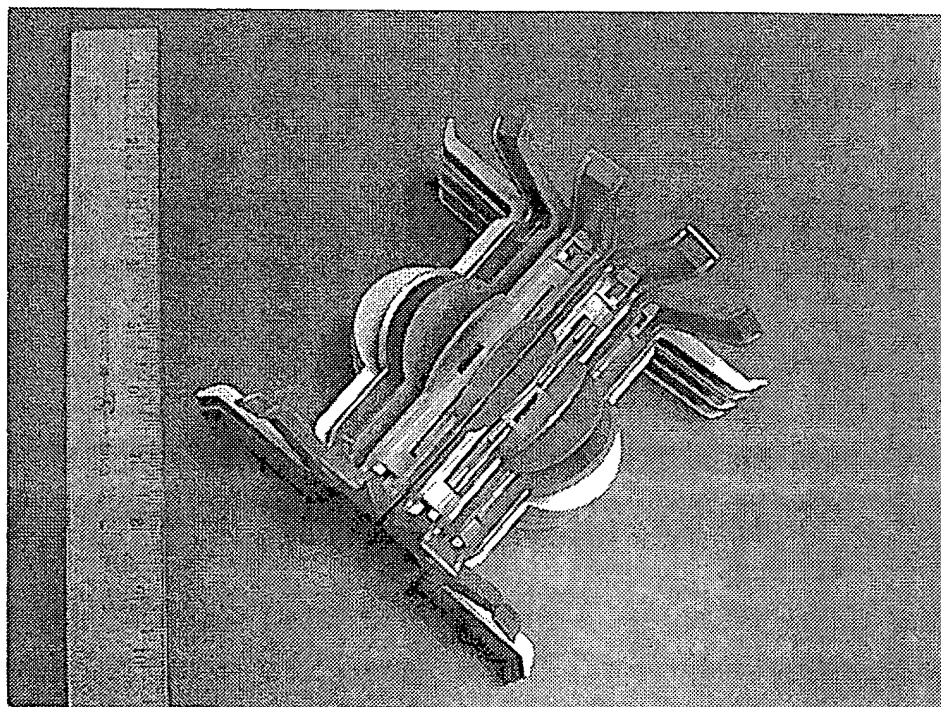


FIG. 3B
(BROOKSTONE COPY)

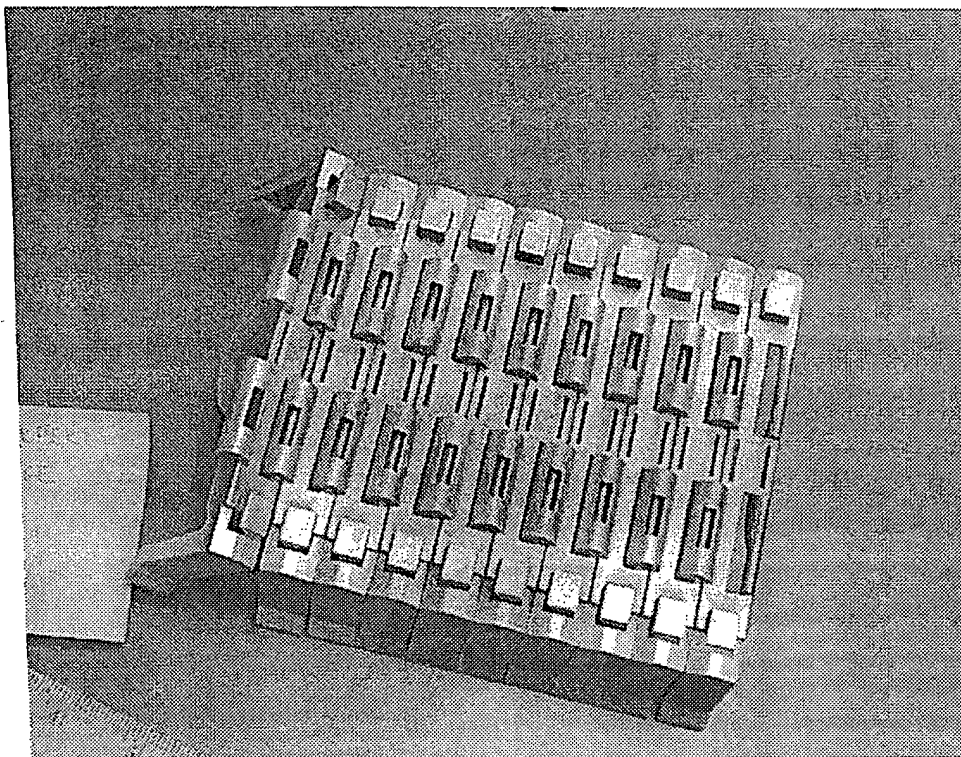


FIG. 4A
(SHARPER IMAGE)

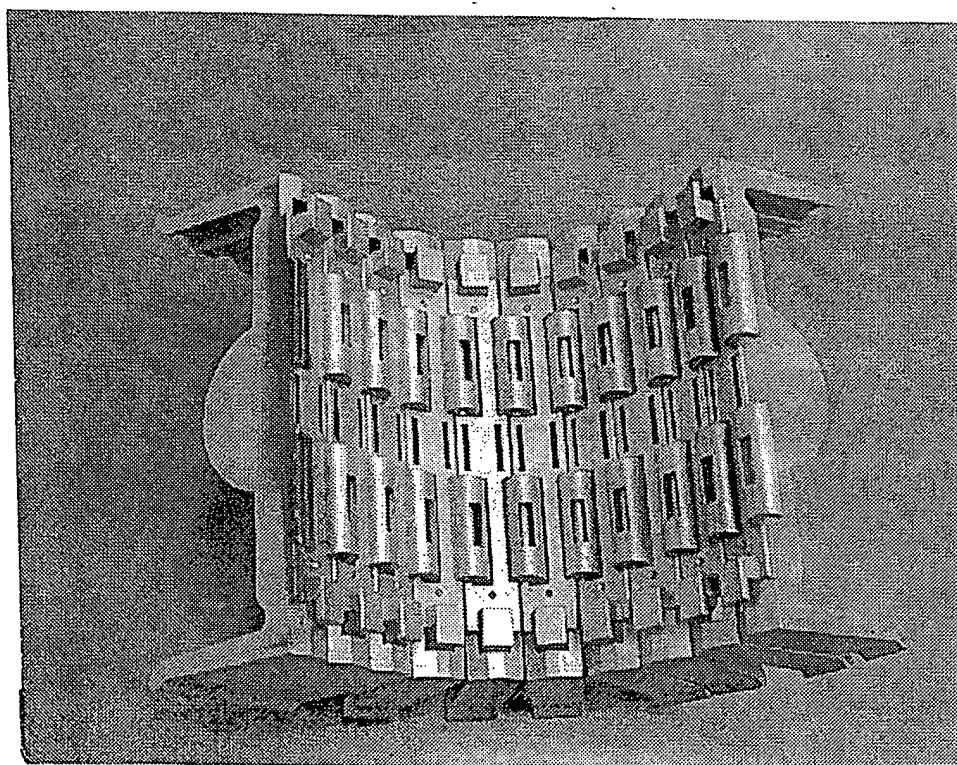


FIG. 4B
(BROOKSTONE COPY)

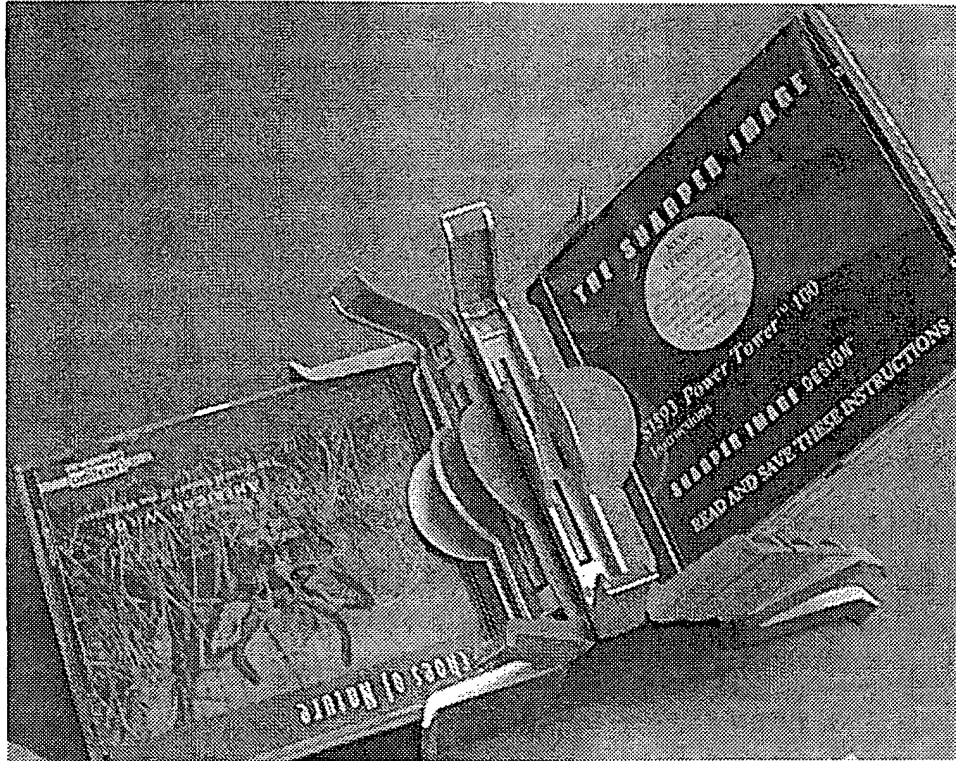


FIG. 5A
(SHARPER IMAGE)

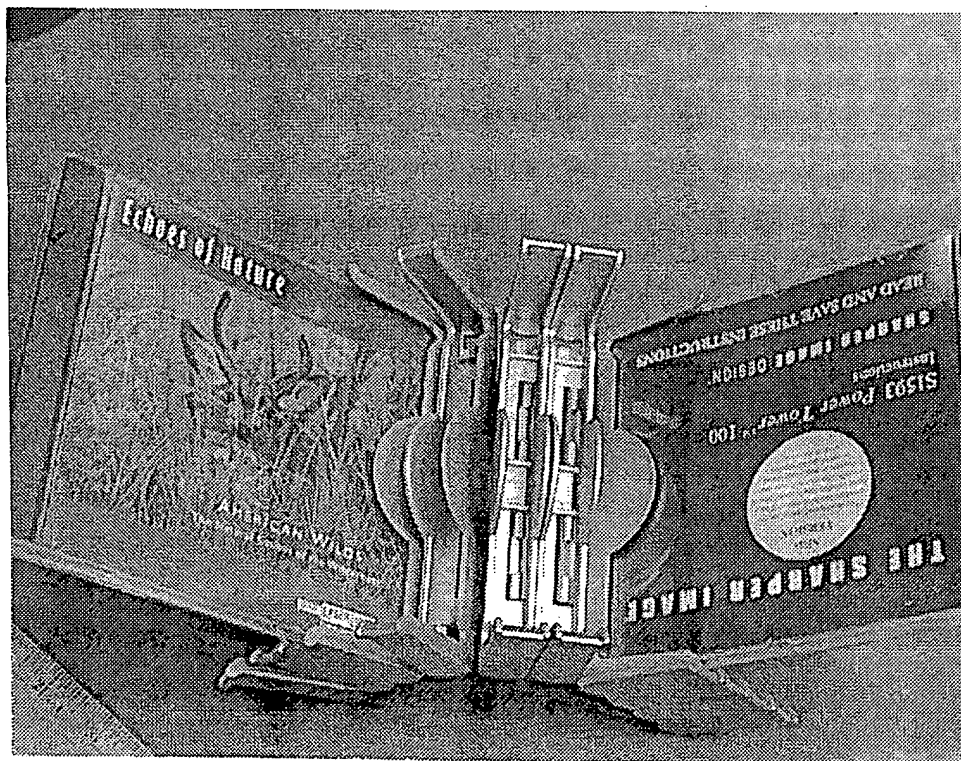


FIG. 5B
(BROOKSTONE COPY)

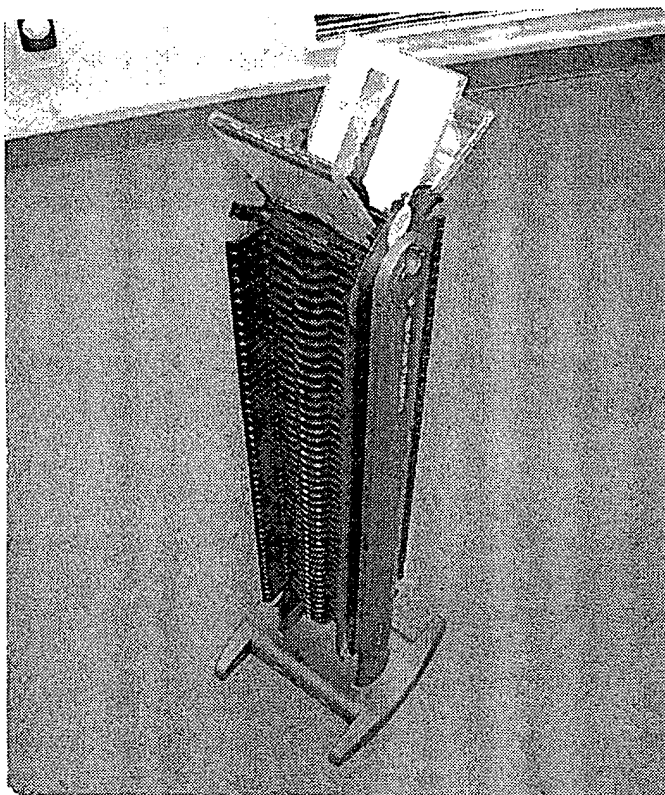


FIG. 6A
(SHARPER IMAGE)

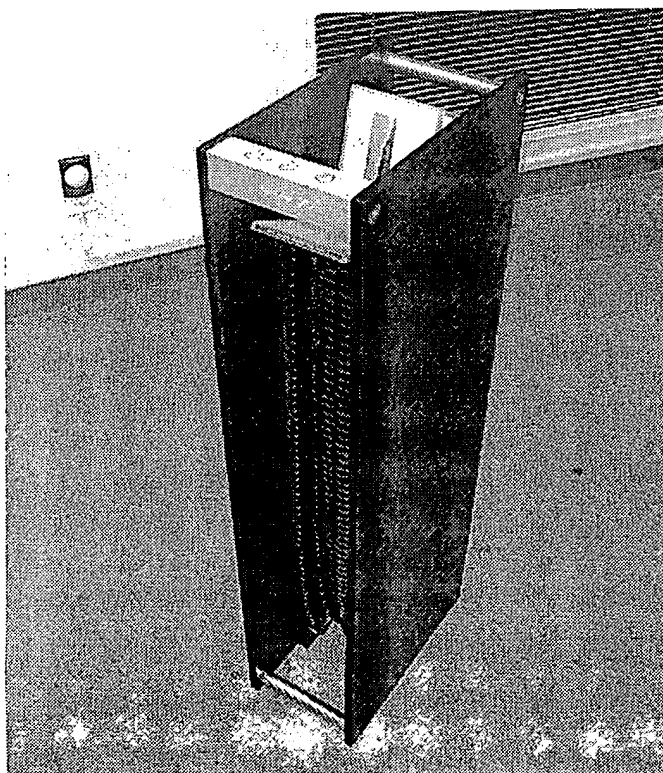


FIG. 6B
(BROOKSTONE COPY)